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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,057	07/16/2003	Steven Jonathan Spinner	035334-006	2279

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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.		Applicant(s)	
	10/622,057		SPINNER ET AL.	
	Examiner		Art Unit	
	Kathleen M. Christman		3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/17/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION***Drawings***

1. The drawings are objected to because the shading in Figures 5-7 obscures the text of the figures, see 37 CFR 1.84(m). The handwritten flowcharts of Figures 1, 2, and 4 are not easily read-able and reproducible, see 37CFR 1.84(l). Further, applicant is requested to provide a descriptive legend for each of the structural elements in the drawings currently represented in the form of a hollow rectangle, for example those denoted by symbols 208, 204(a-d) and 206(a-d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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2. Claims 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although the specification as originally filed include a mention of psychological test it fails to teach how such tests are implemented in the current invention. Unlike the specific details given about the use of physical and physiological tests and the clear understanding of how such relates to the identification of a physical activity compatible with the user, there is no mention of how psychological test can be used to make the same determination or in what manner they are implemented into the current system and method.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 and 18-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 18, 20, 22 and 24 includes the phrase "one specific physical activity more compatible with the person". It is unclear what the identified physical activity is more compatible compared to. Claims 9, 19, and 21 include the phrase "less compatible" and similarly fail to show what the compatibility is actually being compared to. Claims 2-15 and 25 are rejected for their incorporation of one or more of the above through their dependencies.

Claim Objections

4. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 4, 5, 8, 10-14, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarif (US 2004/0029684 A1) in view of Reitman et al (US 6461162 B1). Zarif teaches a method including: subjecting a person to a plurality of test (the fitness interview, Figure 7) and identifying at least one specific physical activity compatible with the user (determining the exercise plan, Figure 6 element 604 and paragraph 35-37), as in **claims 1, 8** and substantially similar limitations in **claims 22 and 24**, and claims 16, 18 and 20 rejected below. The test includes a plurality of physiological tests, specifically at least a height and weight test (**claims 4 and 5**), as shown in paragraph 8. Regarding **claim 9** and claims 19 and 21 rejected below, it is the examiner's position that in determining the best exercises for the user, the Zarif system most inherently determine at least one exercise that is less compatible with the goals of the user. The results of the plurality of tests are stored (**claim 13**), as is shown in paragraph 38. Displaying the at least one physical activity compatible with the person (**claim 14**) is shown in the display of the exercise plan which is inherent to the system, as a user could not execute the plan without seeing what it was.

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Zarif fails to specifically teach: comparing the results of the plurality of test with a database, said database including the results of said plurality of tests subjected to a set of athletes from different physical activities (**claims 1, 22 and 24** and claim 16 rejected below); that the database is periodically updated with a new set of athletes from different physical activities (**claim 10**); and that the physical activity includes a sport (**claim 11**) or a position within a sport (**claim 12**).

Reitman et al teaches a network based system which includes a database of information which includes and is updated with the results of a plurality of tests subjected to a set of athletes from different physical activities, see col. 4: 15-22 and 43-51. The activities are all related to sports or positions with sports, see figure 3a. It would have been obvious to one of ordinary skill in the art to incorporate the features of the Reitman et al system with those of the Zarif system so as to allow a user to determine an exercise program directed specifically to the athletic activity they wish to perform.

Regarding **claim 5**, neither Zarif nor Reitman specifically teaches all of the tests as recited. The examiner takes OFFICIAL NOTICE that resting heart rate tests, standing height test, skinfold tests, body composition test, bone diameter tests, muscle girth tests, and limb and length tests are old and well known in the art of physical fitness. It would have been obvious to one of ordinary skill in the art to include such tests in the Zarif and Reitman et al systems so as to allow for a more complete history of the user prior to designing an exercise regimen.

6. Claims 2, 3, 15, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarif (US 2004/0029684 A1) in view of Reitman et al (US 6461162 B1), further in view of Glasgow (US 2004/0181129 A1). Neither Zarif nor Reitman specifically teach the use of physical tests (**claim 2**); the specific tests mentioned in **claim 3**; and displaying at least one graph illustrating the results of a set of athletes from at least one specific physical activity with respect to the results of said plurality of tests of the person (**claims 15, 23 and 25**). Glasgow teaches the use of physical activity tests in at least paragraphs 22 and 23, Figure 1 and 2 and Table 1. The examiner takes OFFICIAL NOTICE that wobble board tests, hand speed coordination test, grip strength test, vertical jump test, standing long jump test, sit and reach test, foot speed coordination test, pull-ups test, abdominal strength tests, 25-meter sprint

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test, one-turn agility run tests, and cardiovascular endurance tests are old and well-known physical activity tests in the art of physical fitness and personal training. Graphic results are shown in Figure 3. It would have been obvious to one of ordinary skill in the art to implement the tests of the Glasgow system and other well-known tests into the Zarif and Reitman et al inventions so as allow the system to create an exercise program that is based upon a more complete history and profile of the user.

7. Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarif (US 2004/0029684 A1) in view of Reitman et al (US 6461162 B1) further in view of Selles et al (US 2002/0146670 A1). Zarif and Reitman teach all of the features as shown above, but fail to specifically teach: a plurality of testing locations, each testing location having a plurality of testing tools used for subjecting the person to said plurality of tests (**claim 16**). Reitman et al further teaches that each testing location (the remote users) includes a computing device for receiving the results of the plurality of tests and communicates with a server through a plurality of networks, see Figure 1 and col. 3: 17-47. Selles et al teaches a plurality of testing cites including each having a plurality of testing tools in paragraphs 11-13. It would have been obvious to include such a feature into the Zarif and Reitman et al systems so as to input data to enhance the output analysis or recommendations of the system, as suggested by Selles et al.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Comite (US 2002/0194022) teaches a networked system for health management
 - b. Baruch et al (US 2002/0077849) teaches a networked system for health care management

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M. Christman whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M Christman
Examiner
Art Unit 3713

June 22, 2005